

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE APPLICATION OF:

CHRISTINE ANDREIS

CASE NO.: IM1175USPCT

APPLICATION NO.: 09/600,621

GROUP ART UNIT: 1774

FILED: SEPTEMBER 15, 2000

EXAMINER: L. D. FERGUSON

FOR: LOW PIGMENT CONTENT POLYESTER FILM AND PROCESS FOR
MAKING THE SAME

RECEIVED

ARGUMENT

MAR 04 2004

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Reconsideration and withdrawal is respectfully requested of the rejection of claims 1 to 6, 8 to 11, 13 to 19, and 21 to 27 under 35 USC 103(a) as being unpatentable over Shetty et al. USP 5,837,359. No claim has been amended or cancelled since all claims under prosecution represent a patentable advance in the art.

Applicants note the withdrawal of the rejection based on Shetty, et al. USP 4,202,139.

Applicants, in the record of the patent application, have stated a position that the wording of pigment is restrictive due to the words "consisting essentially of". As set forth in the amendment filed June 6, 2003, claim1 contains wording (also required by all claims under prosecution) "wherein the pigment is selected from the group and consists essentially of..." followed by the naming of the pigments. The use of "consists essentially of" limits the claim to the specified materials and steps and those that do not materially affect the basic and novel characteristics of the present claims. Attention is respectfully directed to the Manual of Patent Examining Procedure Section 2111.03 wherein it is set forth:

The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s) of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original).

It is directly stated that the wording of the pigments being selected from the group which "consists essentially of" would exclude a pearlescent pigment. The word "pearlescent" is defined as "having the appearance of mother of pearl" in accordance with Webster's Unabridged Third New International Dictionary. As set forth in the Technical Background of the Invention which the present invention is directed:

Thus there is a need for a film that would show good mechanical properties together with good opacity properties, while minimizing the overall pigment content.

In accordance with the above statement, a pearlescent pigment would be excluded from the scope for which the present invention is directed.

In reply, the Office position is directly contrary to applicants' remarks. More specifically, the Office rejection sets forth:

Applicant's remarks to 35 USC 103(a) as being unpatentable over Shetty et al. (U.S. 4,202,139) have been considered but have not been found persuasive. Applicant argues 'consisting essentially of' excludes pearlescent pigment. Examiner disagrees because a pearlescent pigment is analogous to a white pigment, which is claimed by Applicant. Applicant further argues the transparent or translucent property of Shetty's pigment is directly contrary to the purpose of the present invention directed to a need for 'good opacity property' yet 'minimizing the overall pigment content. Because the pearlescent (white) pigment of Shetty is coated with titanium dioxide, the transparent pigment obtains good opacity.

**OFFICE POSITION IS
TECHNICALLY
INCORRECT**

It is applicants' belief that the Office position is centered in the fact that the pearlescent (white) pigment of Shetty et al. (Shetty) namely mica coated with titanium dioxide results in good opacity.

An initial comment in response to this Office position is Shetty states the pearlescent pigments are transparent or translucent to allow light to pass through the multilayer film. The exact wording is present on column 2, lines 38 to 42 as follows:

1. The pearlescent pigments are transparent or translucent to allow the light to pass through to the optical core of the multilayer films and to allow the iridescent colors to pass through the pigments and be visible, resulting in a iridescent film.

Furthermore, Shetty discloses pearlescent pigments scatter light rather than using a pigment to block light in accordance with applicants' invention. More specifically, Shetty discloses on column 2, lines 43 to

2. The pearlescent pigments scatter sufficient light from the edges to result in a non-glossy, satiny film with high haze levels. The light is scattered by the pearlescent pigments within the film and is not a surface phenomenon. Hence, the haze level and the satin effect is not reduced if the film is laminated, coated, etc.

Accordingly, the Office position is considered technically incorrect.

As set forth above, the titanium dioxide coating of Shetty is present in a thickness, or rather thinness, such that the pearlescent pigment has (1) an ability to be transparent or translucent to allow light to pass and (2) an ability to scatter light around edges.

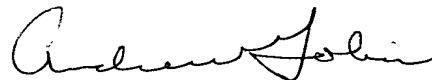
For the purposes of argument only, in the event a titanium dioxide coated mica was employed in applicants' invention, the coating would be sufficiently thick to block the appearance of mica and any resulting pearlescent effect. Such thick coating of titanium dioxide on mica would be unsuitable for Shetty since it would not be (1) pearlescent and (2) transparent or translucent.

Accordingly, applicants have set forth the conclusion that the Office position is technically incorrect.

In summary, applicants' use of "consisting essentially of" bars applicability of Shetty under the provisions of 35 USC 103.

Withdrawal of the grounds of rejection is proper. A notice of allowance is solicited.

Respectfully submitted,



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